

To: OCI Nitrogen B.V. (tadenys@pbnlaw.com)
Subject: U.S. TRADEMARK APPLICATION NO. 79096066 - OCI - N/A
Sent: 8/29/2012 10:01:35 PM
Sent As: ECOM110@USPTO.GOV
Attachments:

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

APPLICATION SERIAL NO. 79096066

MARK: OCI

79096066

CORRESPONDENT ADDRESS:

TODD A. DENYS
PORZIO, BROMBERG & NEWMAN, P.C.
29 THANET ROAD SUITE 201
PRINCETON, NJ 08540

CLICK HERE TO RESPOND TO THIS LETTER
http://www.uspto.gov/trademarks/teas/response_forms.jsp

APPLICANT: OCI Nitrogen B.V.

CORRESPONDENT'S REFERENCE/DOCKET NO. :

N/A

CORRESPONDENT E-MAIL ADDRESS:

tadenys@pbnlaw.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 8/29/2012

INTERNATIONAL REGISTRATION NO. 1073697

The examining attorney has received and reviewed the applicant's correspondence dated July 23, 2012.

In the Final Office action dated February 7, 2012 registration was refused under Trademark Act Section 2(d), as to International Classes 1 and 19, based upon a likelihood of confusion with U.S. Registration No. 3953513. In addition, the examining attorney made Final the requirement for amendments to International Class 19.

In response to the Section 2(d) refusal the applicant has submitted a consent agreement. Based on the

consent agreement, which is unacceptable for the reasons discussed in detail below, the examining attorney is issuing this Subsequent Final Refusal. *See* TMEP §§714.05(d). In response, the applicant has also deleted International Class 19, thereby overcoming the procedural requirement for amendments.

The Final refusal under Trademark Act Section 2(d) as to U.S. Registration No. 3953513 is continued and maintained.

Unacceptable Consent Agreement

The submitted consent agreement is a “naked consent” and is insufficient to overcome a likelihood of confusion refusal because it neither (1) sets forth reasons why the parties believe there is no likelihood of confusion, nor (2) describes the arrangements undertaken by the parties to avoid confusing the public. *See In re Mastic*, 829 F.2d 1114, 1117-18, 4 USPQ2d 1292, 1295-96 (Fed. Cir. 1987); *In re Permagrain Prods., Inc.*, 223 USPQ 147, 149 (TTAB 1984); TMEP §1207.01(d)(viii). Without additional factors to support the conclusion that confusion is unlikely, naked consents are generally accorded little weight in a likelihood of confusion determination. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1362, 177 USPQ 563, 568 (C.C.P.A. 1973).

If applicant submits a more “clothed” consent agreement indicating the registrant’s consent to the use and registration of the mark, and addressing one or both of the factors listed above, this refusal will be reconsidered. However, consent agreements are but one factor to be taken into account with all of the other relevant circumstances bearing on a likelihood of confusion determination. *In re N.A.D. Inc.*, 754 F.2d 996, 999, 224 USPQ 969, 971 (Fed. Cir. 1985); *In re E. I. du Pont*, 476 F.2d at 1361, 177 USPQ at 567; TMEP §1207.01(d)(viii).

Factors to be considered in weighing a consent agreement include the following:

- (1) Whether the consent shows an agreement between both parties;
- (2) Whether the agreement includes a clear indication that the goods and/or services travel in separate trade channels;
- (3) Whether the parties agree to restrict their fields of use;
- (4) Whether the parties will make efforts to prevent confusion, and cooperate and take steps to avoid any confusion that may arise in the future; and
- (5) Whether the marks have been used for a period of time without evidence of actual confusion.

See In re Four Seasons Hotels Ltd., 987 F.2d 1565, 1569, 26 USPQ2d 1071, 1073 (Fed. Cir. 1993); *In re Mastic*, 829 F.2d at 1117-18, 4 USPQ2d at 1295-96; *cf. Bongrain Int’l (Am.) Corp. v. Delice de Fr., Inc.*, 811 F.2d 1479, 1485, 1 USPQ2d 1775, 1779 (Fed. Cir. 1987).

/Jessica Ellinger Fathy/
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TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/teas/eTEASpageE.htm>.

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IMPORTANT NOTICE REGARDING YOUR U.S. TRADEMARK APPLICATION

**USPTO OFFICE ACTION HAS ISSUED ON 8/29/2012 FOR
SERIAL NO. 79096066**

Please follow the instructions below to continue the prosecution of your application:

TO READ OFFICE ACTION: Click on this [link](http://portal.uspto.gov/external/portal/tow) or go to <http://portal.uspto.gov/external/portal/tow> and enter the application serial number to [access](#) the Office action.

PLEASE NOTE: The Office action may not be immediately available but will be viewable within 24 hours of this e-mail notification.

RESPONSE IS REQUIRED: You should carefully review the Office action to determine (1) how to respond; and (2) the applicable [response time period](#). Your response deadline will be calculated from **8/29/2012** (or sooner if specified in the office action).

Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System [Response Form](#).

HELP: For *technical* assistance in accessing the Office action, please e-mail TDR@uspto.gov. Please contact the assigned examining attorney with questions about the Office action.

WARNING

Failure to file the required response by the applicable deadline will result in the [ABANDONMENT](#) of your application.